

Application No.: 10/039957

Case No.: 53325US002

REMARKS§ 103 Rejections

Claims 1, 4, 6, 7, 9, 12, 15, 17, 21-23 and 27-29 stand rejected under 35 USC § 103(a) as being unpatentable over Eigenmann (US 4072403).

Claims 5, 10, 11, 16 and 19 stand rejected under 35 USC § 103(a) as being unpatentable over Eigenmann (US 4072403) as applied above, and further in view of Clark et al. (US 5853846).

According to MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As previously argued, Eigenmann US 4072403 does not disclose a carrier web is the first place, let alone the particular carrier webs being claimed. In addition, none of the references describe a carrier web selected from "a film or nonwoven web of a water-soluble or water-dispersible polymeric material, and a biodegradable material". The use of such carrier webs is advantageous since such webs do not need to be removed from the pavement elements, since such webs will decompose in outdoor environments.

Reconsideration of the application is requested.

Respectfully submitted,

Date

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833

By:

*Carolyn Fischer*  
Carolyn A. Fischer, Reg. No.: 39,091  
Telephone No.: (651) 575-3915

**BEST AVAILABLE COPY**